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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,410	12/18/2000	Tommy Dolan	34647-00430USPT	3692

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ERICSSON INC.
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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,410

Applicant(s)

DOLAN, TOMMY

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Examiner acknowledges the cancellation of claim 2 in the Amendment filed on July 19, 2004.

2. Claims 1 and 3-18 are presented for examination below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,620 by Kingdon et al, hereinafter Kingdon in view of U.S. Patent No. 5,995,848 by Nguyen.

(Note: Kingdon has a common assignee with instant application. Based upon the earlier effective U.S. filing date of Kingdon, Kingdon constitutes prior art only under 35 U.S.C. 102(b).)

Regarding claim 1, Kingdon discloses a method for completing a call from a calling party to a mobile station (MS) of a called party that was not previously completed because of no response by the called party (see Abstract), comprising: sending a request from a Mobile switching center/Visitor location register (MSC/VLR) (Figure 2, 260) of the called party (Figure 2, 200) to inherently activate a movement determination unit to monitor the mobile station of the called party (column 4, lines 19-65); and responsive to monitoring results, one of initiating a callback procedure to the called party to complete the uncompleted call if the MS has moved (column 4, line 66 – column 5, line 21).

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Kingdon does not disclose sending a request from a Mobile switching center/Visitor location register (MSC/VLR) of the calling party to a MSC/VLR of the called party to activate a movement determination unit to monitor the mobile station of the called party and canceling said callback procedure if the MS has not moved.

Nguyen discloses a method for completing a call from a calling party (Figure 5, 151) to a mobile station (MS) of a called party (Figure 5, 145) that was not previously completed because of no response by the called party (see Abstract; see Figure 5), comprising: sending a request from a Mobile switching center/Visitor location register (MSC/VLR) of the calling party to a MSC/VLR of the called party to monitor the mobile station of the called party; and responsive to monitoring results, one of initiating a callback procedure to the called party to complete the uncompleted call if the MS has moved and canceling said callback procedure if the MS has not moved according to a threshold time period or the calling party (column 7, line 59 – column 8, line 67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Kingdon to include sending a request to monitor the MS of the called party and canceling said callback procedure as taught by Nguyen, to complete a call. One of ordinary skill in the art would have been lead to make such a modification since the MSC/VLR of the calling party sends a request to the MSC/VLR of the called party to initiate monitoring the called party in order for a callback procedure to be completed. Also, the callback procedure can be cancelled according to the monitoring results or the calling party.

Regarding claim 3, the method according to claim 1, wherein Kingdon further discloses detecting step for detecting if the MS of the called party has changed its

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location utilizing mobile positioning technology (column 4, lines 35-65; column 5, lines 32-51).

Regarding claim 4, the method according to claim 1, wherein Kingdon further discloses prior to the step of initiating a callback, deciding whether a callback should be initiated when it has been determined that the MS of the called party has moved (column 4, line 66 – column 5, line 21).

Regarding claim 5, the method according to claim 4, wherein Kingdon further discloses the deciding step is based on an input determining that the MS of the called party has moved (column 4, lines 18-34) and at least one further input indicative that the callback may be successful (column 5, lines 15-18).

Regarding claim 6, the method according to claim 5, wherein Kingdon further discloses said step of determining that the MS of the called party has moved comprises making a first determination that the MS of the called party has moved (column 4, lines 19-28; column 4, lines 40-63), and utilizing the at least one further input for making a second determination that the MS of the called party has moved (column 5, lines 33-50).

Regarding claim 7, the method according to claim 6, wherein Kingdon further discloses said first and second determinations are made by first and second movement determination procedures, respectively (column 4, lines 40-63; column 5, lines 33-50).

Regarding claim 8, the method according to claim 5, wherein Nguyen further discloses said at least one further input comprises an expiration of a period of time before said callback is initiated (column 8, lines 59-67).

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Regarding claim 9, the method according to claim 1, wherein Nguyen further discloses the MS of the called party answers a callback attempt prior to contacting the calling party (column 12, lines 20-46).

Regarding claim 10, the method according to claim 1, wherein Nguyen further discloses said method is provided in a call completion service, and wherein said service is available to either of the called party or the calling party (column 8, lines 27-30; column 8, lines 65-67).

Regarding claim 11, the method according to claim 1, wherein Nguyen further discloses further comprising: receiving a call completion request from the calling party before determining whether the called party has moved (column 8, lines 27-30; column 8, lines 51-56).

Regarding claim 12, the method according to claim 10, wherein Nguyen further discloses if said calling party is subscribed to said service, the method further comprising, the step of inquiring if the calling party wants a callback (column 8, lines 27-30).

Regarding claim 13, the method according to claim 1, wherein Nguyen further discloses further comprising canceling the callback procedure if the determining step does not determine that movement has occurred within a set period of time (column 8, lines 59-67).

Regarding claim 14, the method according to claim 11, wherein Kingdon further discloses said determining step includes monitoring the called MS on a periodic basis to determine if it has moved (column 2, line 32 – column 3, line 12).

Regarding claim 15, please see the rejection of the method in claim 1 mentioned above, to reject the apparatus in claim 15, wherein Kingdon further discloses initiating a

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callback procedure to the called party to complete the uncompleted call if the movement determination unit has determined that the MS has moved (column 4, line 66 – column 5, line 18)

Kingdon does not disclose canceling said callback procedure if the MS has moved.

Nguyen discloses a callback unit for one of initiating a callback procedure to the called party to complete the uncompleted call if it is determined that the MS is not busy and for canceling said callback procedure if the MS has not moved a threshold time period has expired (column 8, lines 59-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Kingdon to include canceling said callback procedure as taught by Nguyen, to complete a call. One of ordinary skill in the art would have been lead to make such a modification since the callback procedure can be cancelled according to the monitoring results.

Regarding claims 16 and 17, please see the rejection of the method in claims 1 and 3 mentioned above, to reject the apparatus in claims 16 and 17.

Regarding claim 18, please see the rejection of the apparatus in claim 15 mentioned above, to reject the callback service in claim 18.

Regarding claim 19, the callback service according to claim 18, wherein Nguyen further discloses said service is available to be subscribed to by either the calling party or the called party (column 8, lines 27-30; column 8, lines 65-67).

Response to Arguments

5. Examiner acknowledges the Statement of Common Ownership and 35 USC 112 second paragraph corrections of the Amendment submitted on July 19, 2004.
6. Applicant's arguments, see pages 6-7 of the Amendment, filed July 19, 2004, with respect to the rejection(s) of claim(s) 1 and 3-14 under 35 USC 103(a) as being obvious over Dolan in view of Kallioniemi in further view of Ayoub and claim(s) 15-19 as being obvious over Dolan in view of Kallioniemi have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.
7. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 5,991,620 by Kingdon in view of U.S. Patent No. 5,995,848 by Nguyen for claims 1 and 3-19. Please see all rejections above.
8. Accordingly, **THIS ACTION IS MADE NON-FINAL.**

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- U.S. Patent No. 5,287,551 by Gustafson, Jr et al disclose an apparatus and method for issuing busy call-backs on the voice channel to busied communication units on a trunked radio communication system

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10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302.

The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general
nature or relating to the status of this application or proceeding should be directed to the
Group receptionist whose telephone number is (703) 305-3900.

LH

lh

September 3, 2004

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER